

REMARKS

Claims 11, 14, 16, 17, 19, 21, 22 and 65 were pending. Applicants have herein amended claims 11, 14, 16, 17, and 19 and cancelled claim 65. Support for the amendments can be found throughout the specification, *e.g.*, at paragraphs [0091],[0161], [0172] – [0181], [0187], [0188] [0192], [0193], and [0196]; in the structures of the contrast agents set forth in the specification; and in the Examples; paragraph numbering is as set forth in the present specification's publication, US 2005/0074411. No new matter has been added. Accordingly, claims 11, 14, 16, 17, 19, 21 and 22 are pending.

In light of the amendments and the remarks herein, Applicants respectfully request reconsideration and allowance of the pending claims.

Withdrawal of Prior Rejections

Applicants thank the Examiner for the withdrawal of the previous obviousness-type double patenting rejection, statutory double patenting rejection, and 112 second paragraph rejections. Applicants also acknowledge the Examiner's statement that the claims are free of the prior art.

Rejections under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 11, 14, 16, 17, 19, 21, 22, and 65 as ambiguous for containing various terms. Applicants address each term below in turn:

1) carboxylate precursor group: The Examiner rejected claims 11, 14, 16 and 17 for containing the term "carboxylate precursor group," alleging that it was unclear what groups Applicants claimed to be compatible with the invention. Applicants respectfully disagree, particularly with respect to the amended claims. First, Applicants note that they have deleted the term from claims 11, 14, and 17, thus rendering the rejections moot. Moreover, Applicants note that that the term was not necessary to the claims or an understanding of the invention, given the fact that the structures of precursor chelate moieties, which comprised such carboxylate precursor groups in the unamended claims, are set forth in the claims, with any chemical variables defined explicitly. As can be readily seen from their structures, such precursor chelate

moieties include chemical functionalities that are clearly chemically protected carboxylate moieties, thus allowing synthetic manipulation of the MR imaging agents prior to final chelation of a paramagnetic metal ion by subsequently deprotected carboxylate moieties; *see, e.g.*, paragraph [0091]. As one having ordinary skill in the art would recognize, the protected carboxylate moieties in the claim structures are “carboxylate precursor groups” in that they are “capable of being transformed into carboxylate groups” by well known deprotection chemistry methods; *see, e.g.*, the Examples. Given the fact that Applicants have removed the term from the claims as not necessary to either the claims or an understanding of the invention, Applicants respectfully request withdrawal of the rejections.

2) precursor chelate moiety: The Examiner rejected claims 16, 17, 19, and 65 for containing the term “precursor chelate moiety,” alleging that it was unclear what groups Applicants claimed to be compatible with the invention. Applicants respectfully disagree. Applicants note that the claims set forth the chemical structures of the precursor chelate moieties because the precursor chelate moieties are simply a portion of the covalent conjugates whose structures are explicitly set forth in the claims. Applicants note that the present specification defines covalent conjugates as a covalent linking of a linker moiety and a precursor chelate moiety; *see, e.g.*, paragraphs [0172]-[0181]. Accordingly, one having ordinary skill in the art would be able to determine the precursor chelate moiety structures by simply looking at the covalent conjugate structures set forth in the claims combined with an ordinary understanding of chelate chemical structures. Applicants respectfully request withdrawal of the rejections.

3) activated ester and anhydride: The Examiner rejected claims 11, 16, 17, and 19 for reciting the terms “activated ester” and “anhydride.” Applicants have deleted the term “anhydride” from the claims, thereby rendering the rejection moot. Moreover, Applicants have deleted the phrase “activated ester” from the claims and have added particular chemical moieties for leaving groups (LGs); *see, e.g.*, [0161]. Given all of the above, Applicants respectfully request withdrawal of the rejections.

4) capable of: The Examiner rejected claims 11, 14, 16, 17, 19, 21, 22, and 65, alleging that the claims were ambiguous because the phrase “capable of” was not a positive recitation and that it was unclear whether actual transformations were performed because of the inclusion of such terms. Applicants respectfully disagree and assert that the claims were clear in unamended

form. One having ordinary skill in the art would understand that the recitation of subsequent steps of transformation of groups whose antecedent support was set forth in the “capable of” phrase clearly indicates that the transformations of such groups did occur. Moreover, as indicated under point 1) above, the precursor chelate moieties in the claims include chemical functionalities that are clearly chemically protected carboxylate moieties, which allow synthetic manipulation of the MR imaging agents prior to final chelation of a paramagnetic metal ion by subsequently deprotected carboxylate moieties. As one having ordinary skill in the art would recognize, such protected carboxylate moieties are “carboxylate precursor groups” that are “capable of being transformed into carboxylate groups” by well known deprotection chemistry methods, *e.g.*, as set forth in the subsequent steps in the claims and as demonstrated in the Examples. Nevertheless, in order to further prosecution, Applicants have amended the claims to delete the terms “capable of” Given all of the above, Applicants respectfully request withdrawal of the rejections.

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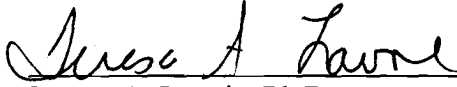
CONCLUSION

Applicants respectfully assert that all claims are in condition for allowance, which action is hereby requested. The Examiner is invited to telephone the undersigned attorney if such would expedite prosecution.

No fee is believed due. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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